

Serial No: 10/509,652

Fechtenkoetter et al.

PF 53410/Sue

REMARKS

Claims 1-9 are currently pending in the application. Claims 1 and 5 have been amended according to the Examiner's suggestions.

REJECTION UNDER 35 U.S.C. § 102(b):

The Examiner rejected claims 1-5 under 35 USC §102(b) as being anticipated by **Oeder et al.** (US 4,406,705). Anticipation under §102 can be found only if a reference shows exactly what is claimed. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (CAFC 1985). The identical invention must be shown in as complete detail as is contained in the patent claim. See *Richardson v. Suzuki Motor co.*, 868 F.2d 1226, 9 USPQ2d 1251, 9 USPQ2d 1913 (CAFC 1989).

The Examiner alleged that **Oeder et al.** discloses a water-emulsifiable hard wax consisting of homogenous terpolymer of ethylene, 1-8 wt % olefinically unsaturated carboxylic acid, and 0.5-10 wt % C₁₋₁₂ alkyl ester of unsaturated carboxylic acid (claim 1). In addition to these components, the Examiner referred to example 17 of the reference urging that it disclosed wax granules emulsified by stirring 20 parts of the terpolymer in [4 parts of non-ionic emulsifier + 0.72 parts of ethylene glycol] and 30 parts of water. The Examiner further took the position that "water-emulsifiable hard wax" reads on "thixotropic agent", and therefore anticipates claims 1-5.

Contrary to the Examiner's assertion, **Oeder et al.** does not disclose all the elements of the currently claimed invention. The currently claimed invention requires a thixotropic agent comprising

1. 0.1 to 30% by weight of an ethylene terpolymer wax synthesized from:
 - a. 80-99.9% by weight of ethylene
 - b. 0.1-20% by weight of:
 - a. 1-99% by weight of C₃-C₁₂ alkenecarboxylic acid
 - b. 99-1% by weight of at least one ester of formula I
2. 5-70% by weight of at least one solvent incompatible with the ethylene terpolymer wax

BEST AVAILABLE COPY

Serial No: 10/509,652

Fechtenkoetter et al.

PF 53410/Sue

3. 5-85% by weight of at least one solvent compatible with the ethylene terpolymer wax

As shown above, both a solvent compatible as well as a solvent incompatible with the wax are constituents of the thixotropic agent of the instant claims. Oeder et al., in example 17, discloses the use of ethylene glycol, which can act as a solvent incompatible with the wax, as disclosed in the current application on page 8, lines 35-42. However, no solvent compatible with the wax is disclosed in the reference. Oeder et al., in example 17, disclose the use of alkyl phenol ethoxylate as an emulsifying agent. However, alkyl phenol ethoxylate is not a solvent. Furthermore, it is a solid at room temperature. Therefore, none of the emulsifying agents of example 17 can be described as a solvent compatible with the terpolymer wax. Because no solvent compatible with the wax is disclosed by Oeder et al., it does not anticipate the current claims. Accordingly, Applicants respectfully request that the §102 rejection be withdrawn.

REJECTION UNDER 35 U.S.C. § 103(a):

The Examiner also rejected claims 6-9 under 103 USC §103(a) as being unpatentable over Oeder et al. According to §103, in order to establish a prima facie case of obviousness, there must be (1) some suggestion or motivation to modify the references, (2) reasonable expectation of success and (3) the prior art reference must teach or suggest all of the claim limitations. See MPEP §2143.

The Examiner takes the position that the difference between the claims of the invention and the disclosure of Oeder et al. is the requirement of the hard wax being applied to a coating process. The Examiner further alleges that because the composition disclosed by Oeder et al. is substantially identical to the one of the present claims, it would have been obvious to one of ordinary skill in the art to adapt the composition of Oeder et al. to a coating process.

However, as described above, the composition disclosed by Oeder et al. is not substantially identical to the present claims. As described above, Oeder et al. do not

Serial No: 10/509,652

Fechtenkoetter et al.

PF 53410/Sue

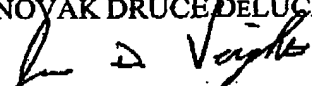
disclose a composition having a solvent compatible with a hard wax, which is required in claim 1. Furthermore, claims 1-5 are not rendered obvious by the disclosure of Oeder et al. There is no suggestion or motivation found in the reference that a solvent compatible with the hard wax be provided. Thus, there is no motivation or suggestion for one of ordinary skill in the art to modify the reference to provide a solvent compatible with a hard wax.

As described above, the composition of Oeder et al. does not disclose the limitations of claims 1-5. Therefore, claims 6-9, which depend from claim 1 are also not disclosed by the teaching of Oeder et al. Furthermore, even if the composition of Oeder et al. were adapted to a coating process, not all the limitations of the current claims would be disclosed because no solvent compatible with a terpolymer wax is disclosed. Moreover, because the composition of Oeder et al. is not substantially identical to the thixotropic agent in claim 1, there is no motivation to adapt it for use in a coating process according to the present claims. Applicant respectfully requests that the §103 rejection be withdrawn.

In light of the foregoing, the Applicant requests that the 35 USC §102 and 35 USC §103 rejections be withdrawn.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,
NOYAK DRUCE DELUCA & QUIGG, LLP


Jason D. Voight
Reg. No. 42,205

JDV/JWB
1300 Eye Street, N.W.
400 East Tower
Washington, D.C. 20005
202-659-0100

-4-
060302

BEST AVAILABLE COPY